

AMENDMENT under 37 C.F.R. § 1.111
U.S. Appln. No. 09/595,557

REMARKS

Claims 2-6, 12-20, 22 and 24-25 were pending in the application (claims 1, 7-11, 21 and 23 were previously cancelled). By this amendment, Applicant amends claims 4 and 12 and adds new claims 26-29, thus claims 2-6, 12-20, 22, and 24-29 are all the claims pending in the present application. Claims 4 and 12 are amended to address potential direct infringement issues and improve clarity. Support for new claims 24-29 is discussed below.

From the Office Action dated March 22, 2004, claims 2-6, 12-20, 22 and 24-25 stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

COMPLIANCE OF AMENDMENT WITH 37 C.F.R. §1.121(h).

This application is a reissue application. Accordingly, the amendments to the claims submitted herewith are governed by 37 C.F.R. § 1.173(b)(2) and do not require a complete listing of the claims specified by 37 C.F.R. §1.121(a) for amendments other than reissue applications.

REISSUE APPLICATIONS.

Surrender of Original Patent

The Office Action takes note that the original patent or statement of inaccessibility or loss of the original patent must be received before this application can be allowed. Applicant is in the process of locating the original application and will either submit the original patent or statement upon the indication that the claims include allowable subject matter.

Declaration

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The Office Action indicates that a supplemental declaration is required before the application can be allowed and the pending claims are rejected under 37 C.F.R. §1.175(b)(1). The apparent alleged deficiency is that Applicant has not declared that errors which are corrected by the reissue application arose without deceptive intent based on the Examiner's reference to the CFR.

However, Applicant believes this statement is clearly present in BOTH the supplemental reissue declaration by the Assignee submitted with the Response on February 6, 2004 (see last line of first box page 2) and the original reissue declaration submitted on June 14, 2000 (see first paragraph page 2). Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection or explain with greater particularity the alleged defects of the declaration and supplemental declaration for this application.

CLAIM REJECTIONS.

35 U.S.C. § 103

Claims 2-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. "Comparisons of Channel-Assignment Strategies in Cellular Mobile Telephone Systems" (IEEE, November 1998) (hereinafter "Zhang") in view of *well known prior art*. Applicant respectfully traverses this rejection for the following reasons.

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

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The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In the case at hand, the Office Action admits the cited prior art fails to specifically teach or suggest several limitations of the rejected claims and relies on the theories of inherency or well known prior art to reconstruct the missing limitations. Applicant respectfully disagrees with both of these assumptions as set forth in the Office Action.

By way of example, the Examiner alleges that the use of a second transmission frequency by a user station different from user station frequencies in adjacent cells is inherent in Zhang because the formation of "a duplex channel." The Examiner is respectfully reminded that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Rather, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. *In re Roberston*, 169 F.3d 743, 745 (Fed. Cir. 1999). In reference to Zhang, the spacing of duplex channels may not be uniform and overlapping frequencies could occur. Additionally half-duplex TDD could also be used.

Furthermore, due to the early priority date of this reissue application; Applicant seasonably challenges the Official Notice taken by the Examiner about the well known prior art TDMA and the alleged obviousness of combining with Zhang. Applicant traverses these assertions and requests the Examiner cite a reference supporting this position; particularly since the Examiner indicated previously (Office Action dated 3/7/2003) that the prior art of record failed to teach or suggest time division duplexing. (Id, pg. 9).

NEW CLAIMS.

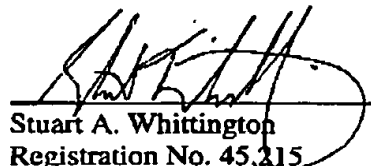
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By this amendment, Applicant adds new claims 26-31 and respectfully requests examination and favorable consideration thereof. Claims 26-31 recite a wireless system similar to the existing claims and support for the limitations in claims 26-31 may be found at: pg. 5, ll. 26 – pg. 6, ll. 3; pg. 6, ll. 10-13; and pg. 6, ll. 20- pg. 7, ll. 2. New claims 26-31 are believed to be patentable for the reasons previously of record.

CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to Deposit Account # 50-0221.

Respectfully submitted,


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